



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,750	07/15/2004	Hans-Martin Dietrich	2002P00211WOUS	1048

7590 01/11/2006
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2686

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/501,750	DIETRICH ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/15/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 20, 21, 26, 28 and 30 are objected to because of the following informalities: "MSC", "SGSN", "BSS", "RAN", "WAP" and "SCP" are not well-known acronyms, they should associate with definitions. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 18-27 and 29-33 are rejected under 35 U.S.C. 102(a) as being anticipated by Havinis et al (US 6,311,069).

Regarding claim 18, Havinis teaches a method for requesting the agreement of a user of a mobile terminal of a mobile radio network to the transfer of their position data to a party requesting this position data (see Abstract), the method comprising: causing, by the switching center of the mobile radio network (Abstract, see "MSC"), in the case of the arrival of a request from a requester for the position of the mobile terminal in the switching center (Abstract, see "MSC" and "positioning request", also see column 2, lines 11-41 and column 3, line 56 to column 4, line 2), a database server to make a check on the basis of data stored there relating to the mobile terminal verification rules as to whether an agreement on the mobile terminal side to forward the mobile terminal

Art Unit: 2686

position to the requester must be obtained (see column 5, lines 41-65), sending the result of this check to the switching center; sending, by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), if the result at least indicates that an agreement must be obtained (see column 5, lines 41-65), a request for an agreement to the mobile terminal; and transmitting, if the agreement is received by the switching center (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), the position of the mobile terminal to the requester (see column 5, lines 41-65 and column 7, lines 10-29).

Regarding claim 19, Havinis further teaches the request arrives at a position data acceptance location of the mobile radio network (see column 6, lines 23-38 and column 7, lines 10-29).

Regarding claim 20, Havinis further teaches the switching center is an MSC or SGSN (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC").

Regarding claim 21, Havinis further teaches requesting, by the switching center, the position of the mobile terminal from a BSS or RAN (fig.1, see "BSS") of the mobile radio network (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC" and "positioning requesting").

Regarding claim 22, Havinis further teaches a verification rules specification can only comprise a prespecified set of different instructions, especially one of the following instructions: position data transfer without notification, position data transfer with notification to the mobile terminal, position data transfer only after agreement of the

Art Unit: 2686

mobile station or if no response is received from the mobile station, only transfer position data with the agreement of the mobile station (see column 5, lines 41-65).

Regarding claim 23, Havinis further teaches storing, for a multiplicity of mobile subscriber identity modules and/or mobile stations, verification rules specifications and identity specifications for the mobile terminal or for a mobile subscriber identity module contained in it (see column 6, lines 23-38, column 1, lines 54-64 and column 7, lines 4-10).

Regarding claim 24, Havinis further teaches regularly receiving, by a switching center, especially a Visitor Location Register of a switching center from the Home Location Register of a mobile network the telecommunications address of the database server or receiving it when a mobile terminal registers at the switching center or its Visitor Location Register VLR (see column 1, lines 25-43 and column 1, lines 55-64).

Regarding claim 25, Havinis further teaches position data is only transferred to a requester if this is allowed for the period of the recording of the position according to stored conditions for the user of the mobile station or its mobile subscriber identity module through attributes stored in the database (see column 3, lines 8-25 and column 5, lines 41-65).

Regarding claim 26, Havinis further teaches changing the conditions by the user via their mobile terminal or another terminal by mobile radio, WAP, Internet, fixed network or in another way (see column 3, lines 8-41 and column 5, lines 41-65).

Regarding claim 27, Havinis further teaches the switching center is the mobile

Art Unit: 2686

switching center currently being used by the mobile terminal (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC").

Regarding claim 29, Havinis further teaches the database server is a database comprising the verification rules specifications and possibly additional attributes and comprising an additional unit which makes the check (see column 1, lines 55-64).

Regarding claim 30, Havinis further teaches storing the entries in the database server but (see column 1, lines 55-64), to make upwards compatibility with a Home Location Register (also see column 1, lines 55-64), which does not support the improvement of the LCS Privacy (see column 5, lines 18-65, "LCS") in accordance with the invention, transmitting entries to a mobile network Home Location Register on request or at regular intervals, so that the mobile network Home Location Register can transmit the entries to a switching center (see column 1, lines 55-64).

Regarding claim 30, Havinis further teaches performing a proportion of the checks (see column column 5, lines 45-53, column 6, line 61 to column 7, line 23) in accordance with a classification in the switching center; and transmitting the result as an additional input parameter to the database server (see column 55-64).

Regarding claim 30, Havinis further teaches storing the entries in a Home Location Register (see column 1, lines 55-64, "HLR"), storing only additional attributes in the database server (see column 1, lines 55-64, "database"), and storing the address of the database server in the Home Location Register (also see column 1, lines 55-64, "HLR" and "database").

Regarding claim 33, Havinis teaches a switching device (see Abstract, column 2, lines 11-41 and column 3, line 56 to column 4, line 2, see "MSC"), comprising an input mechanism for requests from a requester for position data of a mobile station (see column 6, lines 13-22), an output mechanism for transfer of position data to the requester (see column 6, lines 13-22, Abstract, see "MSC" and "positioning request", also see column 2, lines 11-41 and column 3, line 56 to column 4, line 2), and a memory for an address of a database with an interface to a Home Location Register for downloading the address of the database into the memory of the switching device (see column 1, lines 55-64, "HLR" and "database"), wherein the switching device is embodied such that on request for the position of a mobile terminal (Abstract, see "MSC" and "positioning request", also see column 2, lines 11-41 and column 3, line 56 to column 4, line 2), the switching device in accordance with the verification rules specifications transferred to it from the database asks the mobile station for agreement to transfer its position data (see column 1, lines 55-64, "database" and see column 5, lines 41-65).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 2686

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US 6,311,069) in view of Koch (US 6,961,417).

Regarding claim 28, Havinis teaches a claim 18. Havinis does not specifically disclose the database server is arranged in an SCP.

Koch teaches the database server is arranged in an SCP (see column 3, line 64 to column 4, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Koch into the system of Havinis in order to provide real-time status, subscriptions, and modifications of pre-provisioned communication services and parameters (see Koch, column 1, lines 6-10).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Bye (US 6,957,073) teaches mobile location explorer and method therefor.

b. Portman (US 6,944,447) teaches location-based services.

Art Unit: 2686

c. Back (US 6,968,196) teaches location area update in a communication system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

NHL
01/24/05

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600